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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,223	09/17/2003	Kevin L. Parsons	8342-90321	6280
24628	7590	10/20/2004	EXAMINER	
WELSH & KATZ, LTD			BUI, LUAN KIM	
120 S RIVERSIDE PLAZA				
22ND FLOOR			ART UNIT	PAPER NUMBER
CHICAGO, IL 60606			3728	

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/665,223	PARSONS, KEVIN L.
	<b>Examiner</b>	<b>Art Unit</b>
	Luan K Bui	3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 19 August 2004.

2a) This action is **FINAL**.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-17 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-17 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_

1. The Terminal Disclaimer filed on 8/19/2004 has been approved and recorded.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2, 4-8 and 10-16 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Sylvester (5,794,631) in view of Stearns (5,469,965) or Saye (5,575,384).  
Sylvester discloses a packaging (20) for a product comprising a holder (31) holding products such as video cassettes, audio cassettes or compact discs which is considered equivalent to a tray and a card for covering and containing the tray. The card including a first panel (27) folded over a second panel (26) to form an inner compartment (30) for containing the tray and a third panel (22, 42, 43) that serves as a cover. The cover having a first default position when it covers the inner compartment and a second open position when the cover is raised and the inner compartment is exposed. Sylvester further discloses the cover comprising a fourth panel (43) folded over the third panel and the use of fastening means (40) is optional (column 7, line 14). Since the cover formed by the third and fourth panels and due to the weight of the cover and also the use of the fastening means is optional, the cover disposed to remain in the first closed position in contact relation to the inner compartment without locking means. To the extent that Sylvester fails to show a tray for carrying the product, Stearns discloses a packaging (10) for a product comprising a tray (52-54) for carrying a product and a card for covering and containing

the tray including a first panel (18) having a window (20) folded over a second panel (12) having a second window (55) to form an inner compartment therebetween for containing the tray, and a third panel (26, 30) that serves as a cover and folded over the inner compartment. Saye discloses a packaging for a product comprising a tray (62, 66-70) having a flocked surface with a cavity for carrying a product and a card for covering and containing the tray including a first panel (34) folded over a second panel (84) to form an inner compartment therebetween for containing the tray, and a third panel (25, 26) that serves as a cover. It would have been obvious to one having ordinary skill in the art in view of Stearns or Saye to modify the packaging of Sylvester so it comprises a tray for carrying the product for better protecting the product during shipping and/or handling.

As to claim 6, Sylvester fails to show the cover comprises a cut-out portion. Stearns shows the cover comprises a cut-out (57). It would have been obvious to one having ordinary skill in the art in view of Stearns to modify the cover of Sylvester as modified so the cover includes a cut-out for accommodating an article such as a photograph for better retaining the photograph. As to claim 7, Sylvester fails to show the inner compartment being provided with a window. It would have been obvious to one having ordinary skill in the art in view of Stearns to modify the packaging so the inner compartment includes a window to provide visual access to the contents within the inner compartment. As to claim 13, Sylvester discloses a flap (37, 38) connected to the first panel. The tray of Sylvester as modified is capable to carry a flashlight or a medallion.

4. Claims 3, 9, 12 and 17 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 1 and 7 above, and further in view of Heuer et al. (4,739,353; hereinafter Heuer'353) or Appelbaum et al. (5,409,105; hereinafter Appelbaum'105). Sylvester further fails to show the window being a clear lid placed over a raised portion of the tray. Heuer'353 shows a packaging comprising a tray (4) having a raised portion with at least one cavity (11) for carrying a product and a package (16) having a window (17) with a clear lid (4b) placed over the raised portion of the tray. Appelbaum'105 teaches a packaging comprising a tray (34) having a raised portion (32) for carrying a product and a package (20) having a window (24) with a clear lid placed over the raised portion of the tray. It would have been obvious to one having ordinary skill in the art in view of Heuer'353 or Appelbaum'105 to modify the packaging of Stearns so the tray includes a raised portion and the window includes a clear lid placed over the raised portion for better display the product and further protecting the product.

#### *Response to Arguments*

Applicant's arguments filed on 8/19/2004 have been fully considered but they are not deemed to be persuasive.

Applicant argues that "item 31 of the Sylvester patent is not a holder but is instead a cassette" is noted. Since Sylvester is not clearly disclosed whether the item disposed within a holder and then inserted into the gift package (20) or the item itself inserted into the gift package, the Examiner has been assumed that Sylvester fails to disclose a tray for holding the item (see

the last two lines on page 2 of the previous office action) and each of Stearns or Saye patent shows the tray for holding the item.

Applicant's argument with respect to the locking/fastening means (40) of Sylvester patent is noted. This is not persuasive because Sylvester is clearly indicated that the use of locking/fastening means (40) is optional (column 7, line 14). Sylvester further discloses the chamber (30) is constructed for securely receiving and retaining the item (31) (column 5, lines 43-44) which is considered to the item cannot fall out from the chamber.

The teaching of the tray for holding the item during shipping and handling is old and conventional as shown by either Stearns or Saye. There does not appear to be anything unobvious about using the teaching of Stearns or Saye in the gift package of Sylvester for better protecting the item. Regarding the gift package of Sylvester as modified includes the gift package with the tray for holding the item would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luan K. Bui whose telephone number is (703) 305-5861. If in receiving this Office Action, it is apparent to Applicant that certain documents are missing from the record for example copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers should be directed to TC 3700 Customer Service at (703) 306-5648.

Any inquiry of a general nature or relating to the status of this application should be directed to the Customer Service whose telephone number is (703) 306-5648. Facsimile correspondence for this application should be sent to (703) 872-9306 for Formal papers and After Final communications.



Luan K. Bui  
Primary Examiner

lkb  
October 19, 2004